

REMARKS/ARGUMENTS

Prior to entry of this amendment, claims 1, 6, 7, 9, 21, 26, 27, 29, and 30 were pending in this application. Claims 1, 6, 21, 29, and 30 have been amended, no claims have been canceled, and no claims have been added herein. Therefore, claims 1, 6, 7, 9, 21, 26, 27, 29, and 30 remain pending. The Applicants respectfully request reconsideration of these claims for at least the reasons presented below.

Claim Objections

The Office Action has objected to claims 1 and 6 for matters of consistency in that the claims refer to both “e-mail” and “email.” Accordingly and for the sake of expediency in moving this matter toward allowance, the Applicants have made amendments herein to address these objections and change formal matters as suggested by the Office Action. These amendments are thought to fully address the objections as outlined by the Office Action. Therefore, the Applicants respectfully request withdrawal of the objections.

35 U.S.C. § 103 Rejection, Garrigues in view of Lalonde

The Office Action has rejected claims 1, 6, 7, 9, 21, 26, 27, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Pub. No. 2003/0200267 of Garrigues (hereinafter “Garrigues”) in view of U.S. Patent Pub. No. 2004/0068542 to Lalonde et al. (hereinafter “Lalonde”). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims, as amended. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, all claimed limitations must first be taught or suggested by the prior art. *See, e.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). The Office Action must then provide an explicit analysis supporting the rejection. *See KSR Int’l Co. v. Teleflex*

Inc., 127 S. Ct. 1727, 1741 (2007) (“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”). While the Office Action can use one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Office Action to demonstrate that all the claim elements are shown in the prior art. *See* MPEP §2143. As will be discussed below, the references cited by the Office Action do not teach or suggest each claimed limitation.

As argued previously, the Applicants respectfully maintain that Garrigues fails to disclose such recitations or handling receipt of said electronic mail message at the intermediate mail agent for the destination device, including comparing the indication of the address of the source device sending the received electronic mail message against an address of a source device sending a request for authorization that is included in an authorization indicator received in the electronic mail message. Garrigues is directed to “controlling unsolicited email.” (paragraph 2) Under Garrigues:

“An email system for controlling unsolicited email may include a server to manage email messages. The server may be configured to receive an email message from a sender. The email message may include a destination address of an email client and may include a code. If the included code is not a valid authorization code, the email server may not provide the email message to the email client. A request code for requesting an authorization code may be provided to the sender. If the email server receives an email message including the request code from the email sender, the email server may provide a portion of the email message to the email client for determining whether or not to provide an authorization code to the email sender.” (Abstract)

However, Garrigues does not disclose, expressly or inherently, handling an electronic mail message including an authorization indicator as recited in the pending claims. Rather, Garrigues describes parsing a received address to identify a code appended to the destination address, looking up in a database a stored code for that address, and determining if the email is valid based thereon, i.e., by comparing the code appended to the destination email address and the code stored in the database for that address. The Applicants respectfully contend that this is significantly different from comparing a sender’s address to a address identified by an

authorization indicator, both of which are included in the email, i.e., to be sure that the address sending the email is the same as the one that was authorized and to which the authorization indicator was sent/returned.

In response to these arguments, the Office Action seems to agree, at least in part, and introduces Lalonde in an effort to demonstrate a suggestion of such recitations as comparing a sender's address to an address identified by an authorization indicator, both of which are included in the email. However, the Applicants respectfully contend that Lalonde fails to correct the deficiencies of Garrigues. More specifically, the Office Action cites paragraph 39 of Lalonde as allegedly teaching such a comparison. Regarding a comparison, paragraph 39 of Lalonde states in part:

“The method 100 parses the header, in particular the transmission mail header 42, to obtain a purported IP address 62 from the RECEIVED field 56 (see block 102). Thereafter, at block 104, the method 100 interrogates or communicates with the DNS 32 (see FIG. 1) during which the actual domain name of the sender 60 extracted from the RECEIVED field 56, is communicated to the DNS 32 to obtain an IP address associated with the domain name extracted from section 60. The DNS 32 returns an IP address associated with the actual domain name as shown by line 36 in FIG. 1 (the actual IP address of the actual originator). At decision block 106, the method 100 then compares the actual IP address obtained from the DNS 32 with the purported IP address 62 provided in the RECEIVED field 56 and, if they do not match, a low authenticity indicator is displayed to the user as shown at block 108.”

That is, Lalonde describes performing a DNS query to request the IP address for a domain name of the sender of the email. Lalonde then compares the address returned from the DNS server in response to this query to the IP address from which the email is received. The Applicants respectfully contend that this is significantly different from the comparison recited in the pending claims. For example, the comparison of Lalonde cannot reasonably be read to even remotely suggest comparing two addresses that are included in a received email message (one of which is included in an authorization indicator). Even if the Office maintains that Lalonde can be read as suggesting such, the Applicants must respectfully ask, what then is the purpose of the DNS query of Lalonde?

Additionally, Lalonde describes comparing the address from which an email is received with the IP address of the domain identified by the sender and returned from the DNS server. That is, Lalonde compares the actual IP address of the domain of the purported sender with the IP address from which the email is actually received. The Applicants respectfully contend that this is significantly different from and cannot reasonably be considered to suggest comparing a sender's address to a address identified by an authorization indicator, i.e., to be sure that the address sending the email is the same as the one that was authorized and to which the authorization indicator was sent/returned, as recited in the pending claims. Therefore, the combination of Garrigues and Lalonde fails to teach or suggest each claim recitation. For at least these reasons, the Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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